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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,815	09/26/2000	Yuichiro Imanishi	782_133	4229

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EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 07/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/669,815

Applicant(s)
Y. IMANISHI et al.

Examiner
Kishor Mayekar

Art Unit
1753



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 28, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 3, and 11-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 and 9 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of invention of Group 1, claims 1 and 4-10 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the "search and examination of the entire application could be made without serious burden". This is not found persuasive because the record reflects that all these groups are patentably distinct and have been properly considered.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 2, 3 and 11-39 drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Specification

3. The copy of the specification is objected to because the copy is not so clear as some of the words or characters have to be guessed. If the application is to be disposed of, it would have numerous error during the printing. It is requested that Applicant submits a clean copy of the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 5, the claim is indefinite because the claim cannot be depend on itself. The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 7, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the

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application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9 and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by BEST et al. (6,517,786). See the abstract; Fig. 3; col. 4, lines 64-67 and col. 6, line 1 through col. 7, line 8.

9. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over BEST '786 in view of YAMAMOTO (5,843,288) and/or MASUDA (4,665,476). The difference between BEST and the instant claims is that the discharge plasma is of a

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pulsed corona discharge plasma. YAMAMOTO, a reference cited by Applicant, shows in a method of decomposing toxic compounds using catalysis-assisted plasma process the above limitation (see Figs. 5A-5E). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified BEST's teachings as suggested by YAMAMOTO because the selection of any of known equivalent corona discharge would be within the level of ordinary skill in the art.

As to the subject matter of claim 8, YAMAMOTO discloses in the first paragraph of col. 6 the use of pulsed power source from MASUDA. And MASUDA shows in the paragraph crossing cols. 7 and 8 the above limitation.

10. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILLIAMSON et al. (5,695,619) in view of BARLOW et al. (5,914,015). WILLIAMSON's invention is directed to a gaseous pollutant destruction method using self-resonant corona discharge. WILLIAMSON discloses in Fig. 7 and col. 6, line 66 through col. 7, line 5 the recited steps of generating and flowing. The difference

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between WILLIAMSON and the above claims is the provision of treating the substances by catalysis of at least part of the electrodes. BARLOW, another reference cited by Applicant shows in a method for processing exhaust gas with corona discharge the above limitation (see abstract). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Williamson as suggested by BARLOW because this would result in further reaction or neutralization of the gas to be treated.

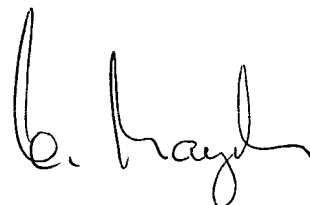
11. Claims 1, 4-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILLIAMSON et al. (5,695,619) in view of YAMAMOTO '288) and/or MASUDA '476, for the same rejection as applied to the paragraph 9 above with respect to WILLIAMSON and to the paragraph 8 above with respect to YAMAMOTO and/or MASUDA.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'K. Mayekar', with a stylized, cursive script.

Kishor Mayekar
Primary Examiner
Group 1700

KM

June 30, 2003